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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,175	01/20/2004	Sau Chu Chan	CA920030066US1	2047
58139	7590	10/01/2008	EXAMINER	
IBM CORP. (WSM)			GARG, YOGESH C	
c/o WINSTEAD SECHREST & MINICK P.C.				
P.O. BOX 50784			ART UNIT	PAPER NUMBER
DALLAS, TX 75201			3625	
			MAIL DATE	DELIVERY MODE
			10/01/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/761,175	<b>Applicant(s)</b> CHAN ET AL.	
	<b>Examiner</b> Yogesh C. Garg	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,9 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,9, and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's amendment filed 7/10/2008 is entered. Claims 1 and 9 are amended. Claims 1, 9, and 12 are pending for examination.

### ***Response to Arguments***

2. Applicant's arguments filed 7/10/2008 have been fully considered but they are not persuasive.

The applicant argues that the current amendment to claim 9 clarifies that the steps of claim 9 are not performed mentally and therefore rejection under 35 USC 101 should be withdrawn. The examiner respectfully disagrees because the recitation "computer implemented method" in the preamble has not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the preamble recites the purpose of a computer implemented process that is providing an e commerce catalog but the body of the claims does not depend on the preamble for completeness but, instead, the process

steps, as recited, are able to stand alone as they can be implemented manually without using a computer.

The applicant argues that the prior art of Flaxer does not teach providing for the catalog a non targeted product set, where the non targeted product set is made available to public customers or to targeted customers (see pages 7-9). The examiner respectfully disagrees. Claims 1, 9 and 12 recite similar limitations of providing for a catalog different types of data including targeted product set and non targeted product set. All the targeted products form a master targeted product. Therefore, the manipulative function of the claimed invention is of providing data related to different types of products and if any structure of a method and system, as disclosed in Flaxer, can also provide different types of data for a catalog then the same structure is also capable of providing any data irrespective of the fact it is related to a targeted product or non targeted product or master targeted product set. None of the claims recite a determining /filtering step to separate the targeted products data and non targeted products data. In absence of this determining/filtering limitation it amounts to that claims 1, 9 and 12 are directed to providing data for catalogs and that data could include several types including data related to targeted products or non targeted products and therefore any structure that is capable of providing several types of data for a catalog can also provide data related to targeted products or non targeted products. Providing mere different types of data without including the steps of determining and separating the different types of data does not warrant patentability over Flaxer because Flaxer clearly teaches (see paragraph 8) providing different types of data for a catalog such as

subset catalogs for group entitlement exclusively targeted to a distinguished membership [correspond to the recited master targeted and targeted product sets. Master targeted product set is made up of a plurality of targeted products set and Flasher teaches providing a plurality of targeted subset of catalogs for group entitlement] as well as providing data for all customers (see paragraph 8, "*..Customizable solution bundles, on the other hand, span all membership groups without restriction and the same instance of a solution bundle may be **arbitrarily included for all customer types** at the discretion of the marketing and sales administrators.*) and this data meant for all customers that is not meant for a private group of customers/distinguished members is meant for public viewing.

The applicant further argues that there is no language in Flaxer disclosing a master targeted product set determined in accordance with terms and conditions of trading agreements between the vendor and the targeted customers (pages 9 and 10). The examiner disagrees. As mentioned above, in Flaxer, the targeted product set corresponds to a subset catalog of products targeted for group entitlement exclusively targeted to a distinguished membership and such plurality of subset catalogs form a master catalog (see at least paragraph 8). These products are determined corresponding to terms and agreements of entitled pricing and business rules between the vendors and customers (see at least paragraph 8).

In view of the foregoing, the rejection of claim 9 under 35 USC 101 and rejection of claims 1, 9 and 12 under 35 USC 102 (e) are sustainable.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 9 recites a process where the body of the claim that is the various steps of providing .... without (1) being tied to another statutory class (such as a particular apparatus) or (2) transforming underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Since neither of these requirements is met by method claims 1-9 and 17, these method claims do not qualify a patent eligible process under 35 U.S.C. 101. The examiner suggests, as an example only, to include a processor/computer/machine coupled to a memory and/or a computer network system implement the recited functional steps in the body of the claim.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(Note: In the earlier rejection the above subject matter was typed wrongly. The grounds of rejection that is rejection under 35 USC 102 (e) was correct and is maintained the same in this rejection as well).

Claims 1, 9 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Flaxer et al., hereinafter Flaxer.

Regarding claim 1, Flaxer discloses an e commerce catalog system comprising a memory unit for storing a computer program for offering a plurality of products for a vendor to prospective customers and a processor coupled to said memory unit, wherein said processor, responsive to said computer program, comprises circuitry for providing a master targeted product set of selected products that is not to be available to non targeted customers, a targeted product set for a targeted customer; and a non targeted product set available to targeted customers (see at least Figs 1-2, paragraphs 0008 and 0024-0027. The subset catalog products and prices for group entitlement correspond to the recited master targeted product set of selected products. The subset catalog products of the customizable solution bundle supporting a unique range of functions including product customization based on programmed business rules correspond to the recited targeted product set for a targeted customer. The subset catalog products of the customizable solution bundle spanning multiple groups being made available to any customer correspond to the recited a non targeted product set available to targeted customers. Figs 1-2 disclose the architecture and flow diagram comprising memory storing computer programs and processor executing programs.);

wherein said non targeted product set is available to public customers (see at least paragraphs 0008 and 0024-0027. The subset catalog products of the customizable solution bundle spanning multiple groups being made available to any

customer and “any customer” includes public customers. );

wherein said catalog presents views of products from targeted product sets to respective targeted customers (see at least paragraphs 0008 and 0024-0027. The subset catalog products of the customizable solution bundle supporting a unique range of functions including product customization based on programmed business rules correspond to the recited targeted product set for a targeted customer and thus the customizable solution bundle presents the views of targeted product sets to targeted customers being supported by programmed business rules);

wherein said catalog presents a view of products from non targeted product sets to targeted customers and public customers (see at least paragraphs 0008 and 0024-0027. The subset catalog products of the customizable solution bundle spanning multiple groups being made available and presented to any customer and “any customer” includes public customers as well as targeted customers);

wherein said master targeted product set is determined in accordance with terms and conditions of trading agreements between said vendor and said targeted customers (see at least paragraph 0024. The entitled group support subset products are determined by a sanctioned business process and tools satisfying both front end and back end fulfillment systems); and

wherein each said targeted product set is determined in accordance with the terms and conditions of a trading agreement between said vendor and a respective targeted customer (see at least paragraph 0026. The subset catalog products of the customizable solution bundle supporting a unique range of functions including product



*customization are based on programmed business rules ).*

Note: The analysis provided above under “Response to Arguments” should also be referred to for the above rejection of claim 1.

Regarding claims 9 and 12, their limitations are closely parallel to the limitations of claim 1 and are therefore analyzed and rejected on the basis of same rationale as set forth for claim 1 above.

### ***Conclusion***

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex/Hoteling.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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